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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,695	01/02/2004	Samuel N. Zellner	030391 (BLL-0125)	4104

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Bedminster, NJ 07921

EXAMINER

NGUYEN, NGA B

ART UNIT

PAPER NUMBER

3692

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DELIVERY MODE

05/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/750,695	ZELLNER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nga B. Nguyen	3692	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 15-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 15-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 27, 2009 has been entered.
2. Claims 1-12 and 15-24 are pending in this application.

### ***Response to Arguments/Amendment***

3. Applicant's arguments with respect to claims 1-12 and 15-24 have been fully considered but are moot in view of new grounds of rejection.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 7-12 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim elements "*means for receiving and storing...*", "*means for receiving data...*", "*means for retrieving...*", "*means for sending...*", "*means for approving...*" are

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means (or step) plus function limitations that invokes 35 U.S.C.112, sixth paragraph.

However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. The written description discloses the general purpose computer but fails to disclose corresponding structure, material, or acts for performing the steps of "receiving and storing, receiving data, retrieving, sending and approving".

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and

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MPEP §§ 608.01(o) and 2181.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-12 and 15-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 7-12 and 22 are rejected under 35 U.S.C. 101 because the claims recite a system contain mere software.

Claims 15-20 and 23 are rejected under 35 U.S.C. 101 because the claims recite “the storage medium inducing instructions” that is not clearly computer executable instructions.

Claims 1-6, 21 and 24 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, claims 1-6, 21 and 24 are non-statutory since they may be performed within the human mind.

*The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.*

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-12 and 15-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tannenbaum, U.S. Patent No. 7,254,548, in view of Ginter et al (hereinafter Ginter), U.S. Patent Application Publication No. 2002/0112171.

Regarding to claim 1, Tannenbaum discloses a method for providing control over transactions, comprising:

prompting a primary user to input financial notification data, the financial notification data operable for defining transaction controls associated with financial transaction initiated by a secondary user (*column 5, lines 25-30, the main user can edit the profile for any sub-account; column 6, line 7-column 7, line 43, the main user can log on to the system to edit the main user or sub-users profiles or establish new profiles; when third parties are to be notified, then the names of the third parties and mode of notification can be set*);

receiving and storing the financial notification data (*column 7, lines 37-40, the notification data is stored in database 16 and profile 17*);

receiving data relating to a financial transaction from a point of sale, the data associated with the secondary user (*column 4, lines 10-15, a parent could allow a child to have a credit card for the purpose of buying clothes, the child then selects is or her purchases at a location and runs card 11 through the card reader at the point of sale*);

retrieving financial notification data related to the financial transaction (*column 4, lines 10-15, the system, via profile 17, database 16, and processor 15, then recognizes that this is a card which is a sub-account card of a main account*);

sending a notification to the point of sale based upon the data relating to the financial transaction (*column 4, lines 15-25, processor 15 enables a communication to the third person identified by profiles 17 via the communication 18, the purchase can only be completed if the third person responds in a positive manner by pushing a button or speaking an acceptance word a set out in the user's profile, the processor 15 then controls the acceptance back to the point of sale*); and

the primary user and issuing a notification to the primary user when the request to execute the financial transaction is approved (*column 3, lines 60-65, the communication can occur for certain of the purchases by category or by amount; column 7, lines 55-58, "if there is not a message is to be sent to the user, or to a third party, and if no other special action is to be taken, then the system would proceed normally"; column 7, lines 34-35, the notification can be with the transaction or thereafter; and column 8, lines 30-35, "this information can be delivered before the completion of the transaction or afterward, and it could be contained on a receipt generated at the POS"*).

Tannenbaum does not disclose the financial notification data including a spending type comprising a time limit imposed on usage of an item that is subject to the transaction controls. However, Ginter discloses the financial notification data including a spending type comprising a time limit imposed on usage of an item that is subject to the transaction controls (*paragraph [2032], a consumer wants to control his family electronic appliance used of his VISA card and prevent his children from playing too many video games; the consumer creates the second budget (time budget) is a "self-replenishing"*



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*security/control budget, that allows, for example, two hours of use per day. The second budget is added as a new required method to permissions records for video games.*

*Since the time budget is required to access the video games, an effective control path is introduced for requiring the second budget--only permissions records modified to accept the family budget can be used by the children for video games and they are limited to two hours per day). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Tannenbaum's to incorporate the feature taught by Ginter above, for the purpose of setting control limits for video games.*

Regarding to claim 2, Tannenbaum further discloses wherein said financial notification data specify conditions for performing at least one of: denying a request to execute the financial transaction; confirming an identity of the secondary user before approving said financial transaction; and suspending future financial transaction activities of the secondary user (*approving a request to execute the financial transaction, column 5, lines 5-17, confirming an identity of the secondary user before approving said financial transaction, comparing the live picture of the user with the picture in the database*).

Regarding to claim 3, Tannenbaum further discloses wherein the spending type further includes at least one of: a type of transaction; a listing of items or services associated with the transaction; a type of merchant; a time of day; a spending limit; and a location type (*column 7, lines 7-20, a listing of items or services associated with the transaction*).

Regarding to claim 4, Tannenbaum further discloses:

presenting a user interface screen with a menu of transaction control items and transaction control rules, the control items organized into, and presented via the user interface as, categories (*figures 2 and 3A, column 5, lines 50-60, the system 20 in which user 200 is utilizing keyboard 22 and computer 23 to access his or her account via communication links 201-1 and 210-2 and public network 24 to web portal 25; the user can obtain account information any time on a category by category basis, or for establishing various account categories, balances and sub-users*);

wherein receiving the financial notification data from the primary user includes receiving one of a user-selected control item, category of control item, and user-defined control item from the primary user via the user interface screen (*figures 5-7 and column 8, line 45-column 9, line 25*).

Regarding to claim 5, Tannenbaum further discloses wherein the notification to the point of sale and the primary user are presented via at least one of: a point of sale terminal; a transaction receipt; a computer screen; a telephone; postal mail; a messaging application; and an online service (*a point of sale terminal, column 4, lines 10-25*).

Regarding to claim 6, Tannenbaum further discloses wherein the notification to the point of sale comprises at least one of: an account balance; an account shut-off; a denial of a request to execute said financial transaction; a request for an additional authorization code; and a request to check an identification of said secondary user (*a request to check an identification of said secondary user, column 5, lines 5-17*).

Claims 7-12 are written in means that parallel the limitations found in claims 1-6 above, therefore, are rejected by the same rationale.

Claims 15-20 are written in computer storage medium that contains the same limitations found in claims 1-6 above, therefore, are rejected by the same rationale.

Regarding to claims 21-23, Tannenbaum does not disclose wherein in the primary user is a merchant. However, Tannenbaum does disclose the third parties, such as parents, employers, debt counselors and **others**, could be notified (*column 3, line 60-column 4, line 10*). Moreover, notifying merchant regarding to a transaction is well known in the art. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Tannenbaum's to include "merchant" in the third parties for notification regarding to the transaction, for the purpose of notifying the merchant in order to enhance the security when executing the transaction involving the sub-user account.

Regarding to claim 24, Tannenbaum does not disclose wherein the item is video gaming and the transaction controls include setting limits on the item by: time, usage, game type and total gaming cost. However, Tannenbaum discloses the transaction controls include setting limits on the item by: usage, type and total cost (*column 7, lines 7-20, a listing of items or services associated with the transaction*). Moreover, Ginter discloses wherein the item is video gaming and the transaction controls include setting limits on the item by: time (*paragraph [2032], a consumer wants to control his family electronic appliance used of his VISA card and prevent his children from playing too many video games; the consumer creates the second budget (time budget) is a "self-*

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*replenishing" security/control budget, that allows, for example, two hours of use per day. The second budget is added as a new required method to permissions records for video games. Since the time budget is required to access the video games, an effective control path is introduced for requiring the second budget--only permissions records modified to accept the family budget can be used by the children for video games and they are limited to two hours per day).* Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Tannenbaum's to incorporate the feature taught by Ginter above, for the purpose of setting control limits for video games.

### **Conclusion**

10. Claims **1-12 and 15-24** are rejected.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Nga B. Nguyen whose telephone number is (571) 272-6796. The examiner can normally be reached on Monday-Thursday from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-3600.

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12. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communication intended for entry),

or

(571) 273-6796 (for informal or draft communication, please label

“PROPOSED” or “DRAFT”).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nga B. Nguyen/

Primary Examiner, Art Unit 3692

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May 5, 2009